

ifw



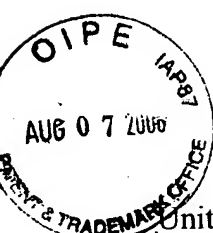
BEHREND & ERNSBERGER, P.C.
ATTORNEYS AT LAW

UNION BANK BUILDING, 3RD FLOOR
306 FOURTH AVENUE
PITTSBURGH, PA 15222

VOICE (412) 391-2515
FAX (412) 391-2762

DANIEL W. CANNON
(1920 - 1998)

KENNETH W. BEHREND
BARBARA BEHREND ERNSBERGER
DANIEL W. ERNSBERGER
KENNETH R. BEHREND



August 2, 2006

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Attn: Gary L. Welch

Re: John J. Stanko
Pocket Protector
Application No: 10/634/620
Our File No: 03-0011

Dear Examiner Welch:

Enclosed please find a Reply to Office Action along with a copy of the Office Action Summary.

Sincerely,

Tamsen Barrett

Tamsen Barrett
USPTO Reg. No. 57,318

Enclosures: Reply to Office Action

cc: John J. Stanko

Re: Applicant: John J. Stanko
Application No. 10/634,620
Pocket Protector
Examiner: Gary L. Welch
Art Unit: 3765
Our File No. 03-0011

REPLY TO OFFICE ACTION DATED May 22, 2006

Response to office action

(Section 102 Rejection)

The Examiner has issued an office action dated May 11, 2006, that rejects claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Bortle (U.S. 3,462,801). The Examiner states that:

Bortle discloses a pocket protector consisting of an outer pocket fabric and an inner pocket fabric secured along their edges to define a pocket 8. A reinforcing material 6 is affixed to and runs down both the outer fabric and the inner fabric since the reinforcing material 6 is sewn into the pocket 8.

The Examiner has rejected the present patent based on a misreading of the Bortle patent.

The abstract in Bortle discloses:

An accessory which lends itself to acceptable use primarily, but not necessarily, in conjunction with one of the half sections of a center folding hip pocket wallet. It is uniquely formed from a single length of resilient wire bent between its ends . . . and is removably contained in the pouch portion of an interior card pocket.

Two key distinctions between the present invention and the Bortle patent arise from this abstract. The first distinction is the cradle design of the wire in the present invention, and the second is the removable nature of the guard in the Bortle patent.

The Bortle patent discloses a guard that is comprised of a single length of wire bent about itself to create a rectangular object useful for keeping a wallet or other item in a pocket.

The Bortle guard is best illustrated in Fig. 3 and is described in the specification, Col. 2 lines 67-73 and Col. 3 lines 1-5 as a frame:

provided at the insertable forward or leading end with a transverse end member 18 integrally joined with spaced parallel co-planar side members 20. The rearward trailing end of one side member 20 is bent as at 22 and then directed at right angles as at 24 and is joined by a second bend or bent portion 26 to the converging end of the complementary guard finger 12. The trailing end portion of the other side frame member 20 is bent as at 28 and then straight across as at 30 and again bent at 32 where it is joined to the converging end of the guard finger 13.

This is not a design intended to cradle the contents of the pocket as disclosed by the present invention. Rather, this frame is intended to maintain the guard fingers in a position appropriate for the invention's purpose. The frame is designed in such a manner as to only slip into the card pocket of the wallet, with a perpendicular bar adjoining two parallel side bars. The Bortle patent does not disclose nor suggest a wire that extends down the outer fabric and up the inner fabric so as to form a cradle. The cradle is an essential element of the present invention, furthering the purpose of preventing a wallet from falling into the hands of the pickpocket.

A second significant distinction is that the guard as disclosed in the Bortle patent is removable from the pocket, not stitched in or permanently affixed to the pocket. The specification in Bortle at Col. 1, lines 42-45 states:

This guard is novel in that it is fully self contained, performs the results desired, is bodily insertable and removable, stays put, and yet is not stitched or positively secured in place in the wallet.

The specification supports your applicant's position by emphasizing the importance of the removable nature of the guard. If the guard were sewn into the pocket as suggested by the Examiner, the removable characteristics of the guard would be lost. The rectangular guard as seen in Fig. 3 is intended to be slid into a pocket, as illustrated in Fig. 2. The specification at Col. 2, lines 37-43 notes:

For simplicity of understanding and description the guard, which is denoted as a unit by the numeral 6, can be construed as used in connection with a center-

folding wallet. To this end the card pocket in the wallet is conveniently denoted at 8 and the guard is made of a size to be fittingly employed in conjunction with the pocket 8.

It is to be noted that this is only an example of the utility of the guard, not as the permanent form of the guard. There is no secure fixation of the guard as shown in Fig. 3 into the pocket of the wallet as shown in Fig. 2. In contrast to the removable nature of the Bortle guard, the present invention discloses the secure attachment of a reinforcing material to both the outer fabric and inner fabric of the pocket. The wire in the Bortle patent is not designed to be affixed to the outer fabric and inner fabric of the pocket by embroidery stitching, iron on patches or button stitches, nor is it designed to be incorporated into the pocket fabric itself. The secure attachment of the wire into the pocket is not disclosed nor suggested by the Bortle patent.

The Examiner also states:

With regard to claim 2, the reinforcing material is stainless steel wire.

Many useful inventions employ stainless steel in a unique manner. This is due in part to the consumer appeal of the material. As emphasized in the present invention's specification, consumers feel comfortable with the level of strength and protection afforded by stainless steel. This comfort level is a factor in the preference of the use of the stainless steel in the present invention, however was not considered as a factor by Bortle. The commonality of the use combined with the consumer appeal prevent the Bortle patent from anticipating the present invention based only on the use of stainless steel.

(Section 103 Rejection)

The Examiner has rejected claims 3 through 6 under 35 U.S.C. 103(a) as being unpatentable over Bortle (U.S. 3,462,801). The Examiner stated:

A review of applicant's specification does not reveal any criticality for affixing

the stainless steel wire to the outer and inner pockets. . . . It would have been obvious to one of ordinary skill at the time the invention was made to substitute embroidery stitching or iron on patches in place of the stitching of Bortle since these fastening mechanisms are functionally equivalent and may be used interchangeably.

The Examiner is mistaken in believing stitching to be involved in the Bortle patent. In Col. 1 lines 44-45, the specification in Bortle specifically states the guard is “not stitched or positively secured in place”. While it is true that various types of fastening mechanisms may in the occasional specific situation be functionally equivalent, that fact is not relevant here. There is no stitching or permanent affixing of the guard to the pocket that is to be obviously replaced by the embroidery stitching or the iron on patches in the present invention. Bortle does not disclose a pocket protector which is securely fastened to the pocket. In contrast, the present invention requires affixing the wire to the pocket in a secure manner, for example by embroidery stitching and iron on patches. This is directly opposed to the pocket protector in the Bortle patent, which is intended to be readily removable. As the wire guard disclosed in the Bortle patent is not affixed to the pocket, use of different methods to affix wire to a pocket is not made obvious by the Bortle patent.

The Examiner also states:

With regard to claims 5 and 6, Bortle disclosed a single strand of stainless steel wire. A review of applicant’s specification does not reveal any criticality for the reinforcing material to be fabricated from multiple strands of stainless steel wire. In fact, the specification states that the reinforcing material can be fabricated from a single strand or from multiple strands. It is well founded that metallic wires are either solid or formed from multiple strands and therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute multiple strands of stainless steel wire for the reinforcing material in lieu of a single solid strand of stainless steel since they are functionally equivalent.

The cradle design of the present invention along with the secure attachment of the wire

inventions. These differences allow the use of similar materials without causing the present invention to be disclosed or fairly suggested by the Bortle patent.

For the above reasons, the present application is ready for issuance and your applicant requests that the patent be issued.

Sincerely,

A handwritten signature in cursive script that reads "Tamsen Barrett". The signature is written in black ink and is positioned below the word "Sincerely,".

Tamsen Barrett
USPTO Reg. No. 57,318